

REMARKS

Claims 1-12 are pending in this application.

Applicants have amended claims 1, 5, 6, and 10-12. The changes to these claims made herein do not introduce any new matter.

Rejection Under 35 U.S.C. § 112

Applicants respectfully request reconsideration of the rejection of claims 5 and 10 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants believe that the phrases “substantially equal” and “substantially reproduces” reasonably apprise one having ordinary skill in the art of the scope of the subject matter defined in claims 5 and 10.

Nevertheless, in compliance with the Examiner’s request and to expedite prosecution of this application, Applicants have deleted the word “substantially” from the foregoing phrases in claims 5 and 10. Accordingly, Applicants submit that claims 5 and 10 satisfy the definiteness requirement of 35 U.S.C. § 112, second paragraph, and request that the rejection of these claims thereunder be withdrawn.

Rejection Under 35 U.S.C. § 103

Applicants respectfully request reconsideration of the rejection of claims 1-12 under 35 U.S.C. § 103(a) as being unpatentable over *Arai et al.* (“*Arai*”) (U.S. Patent No. 5,929,906) in view of *Takahashi et al.* (“*Takahashi*”) (U.S. Patent No. US 6,987,567 B2). As will be explained in more detail below, the combination of *Arai* in view of *Takahashi* would not have rendered the subject matter defined in independent claims 1, 5, 6, and 10-12, as amended herein, obvious to one having ordinary skill in the art.

Applicants have amended each of independent claims 1, 6, 11, and 12 to specify that the image quality index includes either one of a graininess index (GI) indicating graininess of a print and an ink amount index indicating an ink usage amount. Support for the changes

made to claims 1, 6, 11, and 12 can be found in Applicants' specification at, for example, Paragraph [0058].

Neither the *Arai* reference nor the *Takahashi* reference discloses or suggests the use of an image quality index that includes either one of a graininess index (GI) indicating graininess of a print and an ink amount index indicating an ink usage amount. Thus, for at least this reason, the combination of *Arai* in view of *Takahashi* would not have rendered the subject matter defined in present claims 1, 6, 11, and 12 obvious to one having ordinary skill in the art.

With regard to independent claims 5 and 10, Applicants maintain their position that the subject matter defined in these claims is patentable under 35 U.S.C. § 103(a) over the combination of *Arai* in view of *Takahashi* for the reasons previously set forth during prosecution of this application.

Accordingly, independent claims 1, 5, 6, and 10-12, as amended herein, are patentable under 35 U.S.C. § 103(a) over the combination of *Arai* in view of *Takahashi*. Claims 2-4, each of which depends from claim 1, and claims 7-9, each of which depends from claim 6, are likewise patentable under 35 U.S.C. § 103(a) over the combination of *Arai* in view of *Takahashi* for at least the same reasons set forth above regarding the applicable independent claim.

Provisional Obviousness-Type Double Patenting Rejection

In response to the provisional obviousness-type double patenting rejection of claims 11 and 12 as being unpatentable over claim 1 of copending Application No. 10/700,658 in view of *Takahashi*, Applicants are concurrently submitting a terminal disclaimer. Accordingly, Applicants request that the obvious-type double patenting rejection of claims 11 and 12 be withdrawn.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of claims 1-12, as amended herein, and submit that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at **(408) 749-6902**. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP062).

Respectfully submitted,
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